

Remarks

By way of background, this application was filed with a total of 6 claims (Claims 1 and 5 being independent claims, all other claims depending directly or indirectly therefrom).

In the Office Action of April 29, 2005, Claims 2 and 6 were rejected under sec. 112, for indefiniteness (in that these claims, and the claims from which they depend, were said to recite the same limitation); Claims 1, 2, 3, 5, and 6 were rejected under sec. 102 in view of U.S. Pat. No. 5,823,075 to Ahlstone, or U.S. Pat. No. 5,996,444 to Pearce et al; and Claims 1 and 4 were rejected under sec. 102 in view of U.S. Pat. No. 2,263,267 to Franklin. A response was filed to that April 29, 2005 office action, in which certain of the claims were amended, Claim 4 was canceled, and argument presented.

The current Office Action of February 22, 2006 then issued. The sec. 102 rejections were overcome or withdrawn, leaving only sec. 103 rejections as to Claims 1-3, 5, and 6.

The Sec. 103 Rejections

The Office Action rejects the pending claims, under sec. 103. All of the sec. 103 rejections are based on a proposed combination of Ahlstone and the structure shown in the submitted drawings as admittedly prior art. Applicant first disputes the propriety of the proposed combination. It is settled law that there must be some suggestion in the references themselves or the prior art to suggest the combination. A Sec. 103 rejection based on a combination of references requires a prima facie case of obviousness, which in turn has three basic criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the prior art references must teach or

suggest all of the claim limitations. MPEP 706.02(j); 2143. As established by *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000): particular factual findings to support each element must be provided; broad conclusory statements alone are not "evidence." The test for whether a prima facie case exists cannot be satisfied by unsupported statements that a person having ordinary skill in the art would find it obvious to combine references; the Federal Circuit has specifically held that the basis for combining references cannot be met as arising out of "common knowledge" or "common sense." *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Applicant sees no suggestion of a combination, and specifically requests that any future office action rejecting any claims under sec. 103 in view of a combination of references to give specific factual support for said combination.

Addressing the claim rejections and the claims in more detail:

Claims 1-3, 5, and 6 were rejected under sec. 103 "as being unpatentable over Ahlston in view of admitted prior art." Applicant respectfully disagrees.

In Ahlstone, the Office Action refers to Fig. 5, element 70' (as element 70, as shown in Fig. 2, clearly discloses a symmetric jaw insert, which could not constitute a sec. 102 bar to Claim 1). Element 70' is briefly described at Col. 6, lines 30 – 39, as "A second set of jaw inserts 70', one of which is illustrated in Fig. 5, is shaped so as to extend further in a radially inward direction towards the center of the ring gear for engaging a range of small diameter tubes, for example, 1.315 inches to 3.69 inches outside diameter." Beyond this brief written description, and the drawing in Fig. 5, Applicant is left to guess at exactly what structure Ahlstone in fact discloses. Applicant submits that the disclosure of elements 70' of Ahlstone, therefore, does not disclose the invention claimed in Claim 1 as amended; in view of the absence

of any sec. 102 rejections in the present Office Action, Applicant believes that that point is undisputed. The present invention has a function of permitting a *wider range* of tubulars to be gripped, by the shape and geometry of the tong/die, and the fact that it comprises a gripping surface portion along substantially the entirety of its surface.

Ahlstone, by contrast, discloses that the alternate jaw insert 70' is for a *smaller* tubular – *not* a wider range – and in fact a careful examination of Fig. 5 appears to show that element 70' has a teeth only on that portion which would bear against a relatively small diameter tubular, where the jaw is rotated a relatively large degree toward the center of the back-up tong. In fact, from Fig. 5, the apparatus of Ahlstone appears to be inoperable for larger diameter tubulars, since that portion of element 70' which would contact a larger diameter tubular has no teeth (please see Attachment 1, which shows the attributes of element 70' referred to herein). Claim 1, as amended, is therefore clearly not disclosed by Ahlstone, and further is not obvious in view of the proposed combination of Ahlstone and the admitted prior art. Ahlstone apparently also did not appreciate the attribute of Claim 1, as amended, which enables the effective gripping of a wide *range* of tubulars.

Further, Applicant notes the following important distinction between Ahlstone and the invention of Claim 1, as amended. Ahlstone clearly discloses a tool in which three jaw/die combinations rotate to bear against the tubular being gripped. Claim 1, as currently amended, and consistent with the disclosure herein, provides a backup unit having a hook shaped member therein, and in which the tubular is forced into the hook shaped member by contact with a single die/rotatable jaw assembly. Applicant respectfully asserts that the invention of Claim 1, as amended, is non-obvious over the asserted reference, and therefore patentable.

Claims 2 and 3 depend from Claim 1; Claim 1 now being allowable for the reasons set out above, those three claims are also *a fortiori* allowable. Claim 2 has been previously amended to resolve the sec. 112 basis of rejection.

Claim 4 has been canceled, resolving the rejection as to that claim.

Claim 5 has been amended. Applicant invites the Examiner's attention to the argument above related to Claim 1, as to the Ahlstone reference, and adopts those arguments with regard to Claim 5, as well. Additionally, and of key importance, Claim 5 claims a tong assembly, comprising the hook shaped member in combination with the novel tong die shape of the present invention, and wherein only a single rotatable jaw/die assembly contacts the tubular at any time. Applicant respectfully submits that the proposed combination of Ahlstone and the acknowledged prior art neither discloses nor suggests a tong assembly, comprising a backup having a hook shaped member therein, wherein only a single rotatable jaw/die assembly contacts the tubular, and wherein the die has the novel shape set out herein. Applicant asserts that Claim 5, as amended, is patentable over the cited references.

Claim 6 depends from Claim 5, and with Claim 5 allowable, Claim 6 is *a fortiori* allowable.

Claim 7 is new. It depends from Claim 5 and specifies a particular non-symmetric shape (that of a section of the arc of a parabola). Applicant submits that Claim 7 is patentable.

Conclusion

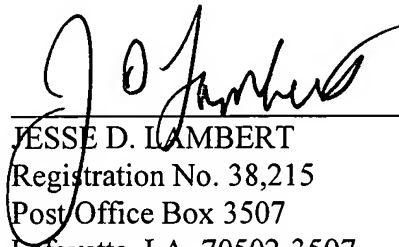
For all of the above reasons, Applicant submits that the claims are in proper form and define patentable subject matter over the cited prior art. Therefore, Applicant respectfully requests allowance thereof.

Applicant further respectfully requests early consideration of this Amendment/Reply, and

allowance of the claims thereafter. Should the Examiner believe that a telephonic interview would be helpful in resolving any further questions, please contact the undersigned at the listed telephone number.

A duplicate copy of this letter is attached.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jesse D. Lambert", is written over a horizontal line.

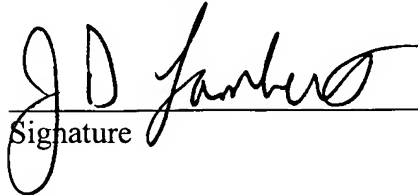
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I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on August 22, 2006.

JESSE D. LAMBERT
Name of Registered Representative


Signature

August 22, 2006
Date of Signature